

Appl. No. : 09/549,988  
Filed : April 14, 2000

### **Procedural History**

Claims 1-26 were originally filed in the application.

In an Amendment and Response to Restriction Requirement faxed on May 24, 2002, Applicant cancelled Claims 25 and 26 in response to the restriction requirement and added Claims 27 and 28. In the June 4, 2002 Office Action, in view of Applicant's election concerning the restriction requirement, the Examiner cancelled Claims 25 and 26.

In this Amendment and Response, Applicant has added new Claims 29-34.

Claims 1-24 and 27-34 are now pending in the application.

In the Office Action, the Examiner rejected Claims 1-11, 13-14, 19-24, and 27 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,018,612 to Thomason et al. ("Thomason").

The Examiner also rejected Claims 12, 16-18, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Thomason.

In addition, the Examiner rejected Claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Thomason in view of EP Patent No. 07249271 to Toshinori.

Applicant has amended Claims 1, 6, 16, 19, 21, 24, and 27 herein in response to the June 4, 2002 Office Action. Claims 1-24, 27, and 28 remain pending for consideration in view of the amendments to Claims 1, 6, 16, 19, 21, 24, and 27.

### **As Amended, Claims 1-15 are Patentable**

The Examiner rejected Claims 1-11 and 13-14 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,018,612 to Thomason et al. ("Thomason"). In addition, the Examiner rejected Claim 12 under 35 U.S.C. § 103 as being unpatentable over Thomason, and rejected Claim 15, also under 35 U.S.C. § 103, as being unpatentable over Thomason in view of EP Patent No. 07249271 to Toshinori ("Toshinori").

Of the Claims 1-15, Claims 1 and 6 are independent claims, with Claims 2-5 depending from Claim 1, and Claims 7-15 depend from Claim 6.

Applicant has amended Claim 1 and Claim 6, and submits that, as amended, both Claim 1 and Claim 6 are patentably distinct over the cited art. Because independent Claims 1 and 6 are patentably distinct, Applicant further submits that the respective dependent claims -- Claims 2-5 and Claims 7-15 -- are likewise patentably distinct.

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In particular, Applicant has amended Claim 1 to recite that the first set of data are recorded "in less time than it takes to play the first set of data." Similarly, Applicant has amended Claim 6 to recite that the "record module records the first stream in less time than it takes to play the first stream." In contrast, Thomason nowhere discloses or suggests recording data in less time than it takes to play the data. Indeed, Thomason discloses receiving television signals as input. See Thomason, column 3, lines 39-43. There is no suggestion or hint as to how such signals may be recorded in less time than it takes to play them. Applicant submits that Claims 1 and 6, as amended, are patentably distinct over Thomason.

#### **Claim 12 Would Not Have Been Obvious**

Regarding Claim 12, Applicant submits that, in addition to the reasons stated above in connection with Claim 6 from which it depends, Claim 12 is patentable over Thomason for additional reasons. In addition to the subject matter of Claim 6, Claim 12 recites that "the first device is a CD-ROM drive." In arguing that Claim 12 would have been obvious, the Examiner merely took official notice that "CD ROM type recording devices are well known and widely used and available type devices." Without any other evidence, the Examiner simply concluded that, "therefore, it would have been obvious to one skilled in the art at the time of the invention" to substitute a CD ROM type device "to perform the same as the hard disk used by Thomason."

The Examiner has apparently not considered the detailed performance reasons, disclosed in Thomason itself, for using a hard disk type device. In particular, Thomason needed buffer memory combined with a hard disk device to cope with demands placed on the system. As Thomason itself states, "[t]he buffer memory 35 enables a single-head hard-disk to cope with the dual task of writing the TV signal being monitored and simultaneously reading out the signal to be displayed." See Thomason, column 4, lines 37-40. The Examiner has provided no evidence that one of ordinary skill would somehow know that a CD-ROM type device would be able cope with that dual task, and also no evidence that a CD-ROM type device could cope with such task. Applicant submits that mere knowledge and availability of a CD ROM device does not constitute sufficient evidence of a motivation or suggestion to use the knowledge of a CD ROM device in the Thomason system. It is well settled in the law, that prior art references may not be combined for the purpose of demonstrating that an invention would have been obvious, unless there is additional evidence -- in the prior art itself -- of a motivation or suggestion to combine the prior art references. Overwhelming legal authority makes clear that, for purposes of combining prior

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art references for a 103 rejection, there must be some evidence of a motivation or suggestion to combine the references that is found in the prior art itself. *E.g., In re Jones*, 958 F.2d 347 (Fed. Cir. 1988); MPEP § 2143.01. Indeed, the MPEP states, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01. Because there is no evidence of any suggestion or motivation to use a CD ROM device in place of a hard disk device in the Thomason system, and for the reasons stated in connection with Claim 6, Applicant respectfully submits that Claim 12 would not have been obvious.

#### **Claim 15 Would Not Have Been Obvious**

With respect to Claim 15, Applicant submits that, in addition to the reasons stated above in connection with Claim 6 from which it depends, Claim 15 is patentable over the cited art for additional reasons. In addition to the subject matter recited by Claim 6, Claim 15 recites that the record module is "configured to perform at least one test on the CD-ROM drive." The Examiner argued that Toshinori teaches performing a test on a CD-ROM device. With no additional reasons, the Examiner then concluded that "[t]herefore, it would have been obvious to one skilled in the art at the time of the invention to modify Thomason by incorporating at least one test to evaluate the CD Rom device or disk memory device."

Applicant respectfully disagrees with the Examiner's conclusion regarding Claim 15. First, Thomason never mentions anything about a CD-ROM device. The Examiner never explained why a person of ordinary skill would ever have thought to combine the teaching to perform a CD-ROM test with a system that teaches using only a hard disk drive. Second, the Examiner cited no evidence at all of any suggestion or motivation in the prior art to combine Thomason and Toshinori. Again, prior art references may not be combined for the purpose of demonstrating that an invention would have been obvious, unless there is evidence of a motivation or suggestion to combine the prior art references. *E.g., In re Jones*, 958 F.2d 347 (Fed. Cir. 1988); MPEP § 2143.01.

Similarly, it is impermissible to use Applicant's claims as a blue print to pick and choose teachings from prior art references to piece together Applicant's inventions. Such a method impermissibly evaluates the patentability of Applicant's invention using, in hindsight, full knowledge of Applicant's invention.

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The Examiner has not provided sufficient evidence to demonstrate that Claim 15 would have been obvious. Applicant respectfully submits that Claim 15 would not have been obvious, and requests that the Examiner withdraw the rejection of Claim 15.

In sum, Applicant respectfully requests that the Examiner withdraw the rejections of Claims 1-15.

**As Amended, Claims 16-24 and Claims 27 and 28 are Patentable**

The Examiner rejected Claims 19-24 and 27 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,018,612 to Thomason et al. ("Thomason"). In addition, the Examiner rejected Claims 16-18 and 28 under 35 U.S.C. § 103 as being unpatentable over Thomason.

Of the Claims 16-24, 27 and 28, Claims 16, 19, 21, 24 and 27 are independent claims. Applicant has amended each of these independent claims.

**Claims 16-18**

Applicant has amended Claim 16 to additionally recite that the encoding of the first stream of audio data is "occurring in less time than it takes to play the first stream of audio data." Thomason nowhere discloses encoding of a stream of audio data, and certainly nowhere discloses or even suggests encoding a stream of data in less time than it takes to play the data. Applicant thus respectfully submits that Claim 16, as amended, is patentably distinct over Thomason. In addition, for the same reasons, Applicant submits that Claims 17 and 18, which depend from Claim 16, are also patentably distinct over Thomason.

**Claims 19-20**

Applicant has amended Claim 19 to additionally recite that the means for recording a first set of streamed data does so "in less time than it takes to play the first set of streamed data." As explained above, Thomason nowhere discloses or even suggests recording streamed data in less time than it takes to play the data. Applicant thus respectfully submits that Claim 19, as amended, is patentably distinct over Thomason. For the same reason, Applicant submits that Claim 20, which depends from Claim 19, is also patentably distinct over Thomason.

**Claims 21-23**

Applicant has amended Claim 21 to recite that the recording of audio data is done "in less time than it takes to play the audio data." Thomason nowhere discloses or suggests recording audio data in less time than it takes to play the data. Applicant thus respectfully submits that

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Claim 21, as amended, is patentably distinct over Thomason. For the same reason, Applicant submits that Claims 22 and 23, which depend from Claim 21, are also patentably distinct over Thomason.

#### **Claim 24**

Applicant has amended Claim 24 to recite that the stream recording of audio data is done “in less time than it takes to play the audio data.” Thomason nowhere discloses or suggests stream recording audio data in less time than it takes to play the data. Applicant thus respectfully submits that Claim 24, as amended, is patentably distinct over Thomason.

#### **Claims 27-28**

Applicant has amended Claim 27 to additionally recite that the incremental recording of the first set of data occurs “in less time than it takes to play the first set of data.” As explained above, Thomason nowhere discloses or suggests incrementally recording a set of data in less time than it takes to play the data. Applicant thus respectfully submits that Claim 27, as amended, is patentably distinct over Thomason. For the same reason, Applicant submits that Claim 28, which depends from Claim 27, is also patentably distinct over Thomason.

#### **New Claims 29-34 are Patentable**

##### **Claims 29-31**

Applicant has added Claims 29-31. Claim 29 recites a computer readable medium having instructions that, when processed, perform a method that includes encoding an audio data file “in less time than it takes to play the audio data file.” As explained above, the prior art of record nowhere discloses or suggests encoding an audio data file in less time than it takes to play the audio data file. Applicant thus respectfully submits that Claim 29, as well as Claims 30 and 31 which depend from Claim 29, are patentably distinct over the cited art of record.

##### **Claims 32-34**

Applicant has also added Claims 32-34. Claim 32 recites a method that includes encoding an audio data file “in less time than it takes to play the audio data file.” Again, the prior art of record nowhere discloses or suggests encoding an audio data file in less time than it takes to play the audio data file. Applicant respectfully submits that Claim 32, as well as dependent Claims 33 and 34, are patentably distinct over the cited art of record.

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**Summary**

In view of the amendments and comments discussed above, Applicant respectfully submits that Claims 1-24 and 27-34 are in condition for allowance and requests the Examiner to pass the application to issuance.

**Request for Telephone Interview**

Should there be any questions or issues that may be resolved via a telephone conversation, Applicant invites the Examiner to contact the undersigned attorney of record, Douglas G. Muehlhauser, at (949) 721-2994 (direct dial) or at the general office telephone number listed below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 12/4/02

By: 

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**VERSION WITH MARKINGS TO SHOW MODIFICATIONS**  
**UNDER 37 C.F.R. §1.121(A)(2)(II)**

The changes made to the claims in the current amendment are shown below. Insertions appear as underlined text, for example, insertions, while deletions appear as bold strikethrough text surrounded by brackets, for example, [~~deletions~~].

1. (Amended herein) A method for recording and playing data, the method comprising:

incrementally recording a first set of data in less time than it takes to play the first set of data; and

incrementally playing a second set of data wherein the incremental playing of the second set of data begins while incrementally recording the first set of data.

6. (Amended herein) A play while record system comprising:

a first device;

a second device;

a record module configured to record on the second device a first stream representing a first set of data from the first device; and

a play module configured to play a second stream representing a second set of data from the second device wherein the play module plays the second stream while the record module records the first stream, and wherein the record module records the first stream in less time than it takes to play the first stream.

16. (Amended herein) A method for playing and simultaneously recording streams of audio data, the method comprising:

receiving a first stream of audio data from a first set of audio data;

encoding the first stream of audio data to produce a first encoded stream of audio data, the encoding of the first stream of audio data occurring in less time than it takes to play the first stream of audio data;

encrypting the first encoded stream of audio data to produce a first encrypted, encoded stream of audio data;

saving the first encrypted, encoded stream of data to a first data file in a first storage location;

reading a second encrypted, encoded stream of audio data from a second data file in a second storage location wherein the reading of the second encrypted, encoded stream of audio data begins while encoding the first stream of audio data;

decrypting the second encrypted, encoded stream of audio data to produce a second encoded stream of audio data; and

decoding and playing the second encoded stream of audio data.

19. (Amended herein) A system for playing streamed data while recording streamed data, the system comprising:

means for recording a first set of streamed data in less time than it takes to play the first set of streamed data;

means for playing a second set of streamed data; and

means for beginning the playing of the second set of streamed data while recording the first set of streamed data.

21. (Amended herein) A method for playing and recording audio data at the same time, the method comprising:

recording audio data in less time than it takes to play the audio data; and  
playing a recorded portion of the audio data during recording of the audio data.

24. (Amended herein) A method for processing audio data comprising:

stream recording audio data in less time than it takes to play the audio data; and  
stream playing the recorded audio data wherein the stream playing of the stream recorded audio data begins before the stream recording of the audio data is finished.

27. (Amended herein) A computer readable media comprising instructions when executed comprise the method of:

receiving a first set of data and a second set of data;

incrementally recording the first set of data in less time than it takes to play the first set of data; and

starting an incremental playing of the second set of data while incrementally recording the first set of data.



29. (Added herein) A computer readable medium having instructions that, when processed, perform a method for encoding and playing an audio data file, the method comprising:

reading and encoding the audio data file in less time than it takes to play the audio data file; and

playing an encoded portion of the audio data file during the encoding of the audio data file.

30. (Added herein) The computer readable medium as described in Claim 29, the method further comprising:

storing the encoded audio data file in at least one of a plurality of encoding formats.

31. (Added herein) The computer readable medium as described in Claim 30, wherein the encoding format is automatically detected for playing the encoded audio data file.

32. (Added herein) A method for playing an audio data file, the method comprising: reading and encoding the audio data file in less time than it takes to play the audio data file; and

playing an encoded portion of the audio data file during the encoding of the audio data file.

33. (Added herein) The method as described in Claim 32, the method further comprising:

storing the encoded audio data file in at least one of a plurality of encoding formats.

34. (Added herein) The method as described in Claim 33, wherein the encoding format is automatically detected for playing the encoded audio data file.